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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JENKENS & GILCHRIST, P.C.		EXAMINER		
1445 Ross Avenue, Suite 3200		REVAK, CHRISTOPHER A		
Dallas, TX 75202-2799				
		ART UNIT	PAPER NUMBER	
		2131		

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/061,802	<b>Applicant(s)</b> EAGLE ET AL.	
	<b>Examiner</b> Christopher A. Revak	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-11, 20-49 and 62-77 is/are allowed.
- 6) ☒ Claim(s) 1, 12-19, 50-61, 78-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see attached</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements submitted are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,12-19, and 55-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson et al, US Patent 6,507,410.

As per claim 1, it is taught by Robertson et al of a system for duplicating documents of disparate types for facilitating searching of such documents, said system comprising storage means for storing at least one original file, each containing no more than one original document, said original file being in a first format; processing means for determining that said original document is a component document of a compound document, extracting said component document from said compound document and

storing said component document in said original file; and conversion means for converting said original file from said first format to a canonical format thereby generating a duplicate file containing a duplicate document of said original document, whereby searching of such documents is facilitated (col. 2, lines 13-30 and col. 21, line 62 through col. 22, line 45).

As per claim 12, Robertson et al discloses wherein said storage means has a directory structure, said component document being stored in said storage means under a directory associated with said compound document (col. 17, line 56 through col. 18, line 17).

As per claim 13, Robertson et al teaches of further comprising duplicate storage means for storing said duplicate file, said duplicate storage means having a directory structure identical to the directory structure of said storage means storing said original file (col. 17, line 56 through col. 18, line 17).

As per claim 14, it is disclosed by Robertson et al wherein said compound document includes an additional component document, said processing means further for extracting said additional component document from said compound document and storing said additional component document in an additional original file in said storage means under said directory associated with said compound document in a hierarchical format designed to preserve the hierarchical relationship between said component document, said additional component document and said compound document (col. 17, line 56 through col. 18, line 17).

As per claim 15, it is taught by Robertson et al wherein said component document and said additional component document are stored in a sub-directory of said directory associated with said compound document (col. 17, line 56 through col. 18, line 17).

As per claim 16, Robertson et al discloses wherein said canonical format is the Portable Document Format (PDF), and further comprising searching means for enabling full-text searching of said duplicate documents (col. 18, line 62 through col. 19, line 3).

As per claim 17, Robertson et al teaches wherein said compound document is an electronic mail folder, an electronic mail message having one or more attachments thereto, an electronic mail message having one or more additional electronic mail messages embedded therein, an execution file or a zip file (col. 17, line 56 through col. 18, line 17).

As per claim 18, it is disclosed by Robertson et al of further comprising appending means for appending a filename to said original file; and renaming means for renaming said duplicate file in a sequenced format based on said filename of said original file (col. 21, line 62 through col. 22, line 45).

As per claim 19, it is taught by Robertson et al of further comprising selection means for enabling selection of said component document from said compound document for storage in said storage means (col. 21, line 62 through col. 22, line 45).

As per claim 55, Robertson et al discloses of a method for duplicating digital documents of disparate types for facilitating searching of such documents, comprising the steps of determining whether an original document is a component document of a

compound document; if said original document is a component document, extracting said original document from said compound document; storing said original document in an original file within a computer system, said original file being in an original format; and converting said original file from said original format to a canonical format, thereby generating a duplicate file containing a duplicate document of said original document, whereby the searching of such documents is facilitated (col. 2, lines 13-30 and col. 21, line 62 through col. 22, line 45).

As per claim 56, Robertson et al teaches wherein said step of storing further comprises the step of storing said original file and said duplicate file in identical directory structures (col. 17, line 56 through col. 18, line 17).

As per claim 57, it is disclosed by Robertson et al wherein said compound document includes an additional component document, and further comprising the steps of extracting said additional component document from said compound document; and storing said additional component document in an additional original file under a directory associated with said compound document in a hierarchical format designed to preserve the hierarchical relationship between said component document, said additional component document and said compound document (col. 17, line 56 through col. 18, line 17).

As per claim 58, it is taught by Robertson et al wherein said step of storing said additional component document further comprises the step of storing said component document and said additional component document in a sub-directory of said directory associated with said compound document (col. 17, line 56 through col. 18, line 17).

As per claim 59, Robertson et al discloses wherein said canonical format is the Portable Document Format (PDF), and further comprising the step of enabling full-text searching of said duplicate documents (col. 18, line 62 through col. 19, line 3).

As per claim 60, Robertson et al teaches of further comprising the steps of appending a filename to said original file; and renaming said duplicate file in a sequenced format based on said filename of said original file (col. 21, line 62 through col. 22, line 45).

As per claim 61, it is disclosed by Robertson et al of further comprising the step of enabling selection of said component document from said compound document for file conversion and storage (col. 21, line 62 through col. 22, line 45).

4. Claims 50-54 and 78-83 rejected under 35 U.S.C. 102(e) as being anticipated by Pasioka, US Patent 6,587,945.

As per claim 50, it is taught by Pasioka of a system for validating the authenticity of digital documents of disparate types, comprising storage means for storing a duplicate file containing a duplicate document of an original document in an original file having an original format, said duplicate file having a canonical format; embedding means for embedding notary data associated with said duplicate file within said duplicate file; and validation means for authenticating said duplicate file using at least said notary data associated with said duplicate file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 51, Pasieka discloses wherein said embedding means for embedding said notary data associated with said duplicate file into said duplicate file further comprises creation means for creating a hole in said duplicate file; original notarization means for determining said notary data associated with said duplicate file by computing a hash value over the contents of said duplicate file excluding said hole; and storage means for storing said notary data associated with duplicate file within said hole (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 52, Pasieka teaches wherein said validation means further comprises extraction means for extracting said notary data associated with said duplicate file from said hole; validating notarization means for determining new notary data associated with said duplicate file by computing an additional hash value over the contents of said duplicate file excluding said hole; and comparison means for enabling comparison of said extracted notary data with said new notary data to authenticate said duplicate file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 53, it is disclosed by Pasieka of a system for validating the authenticity of an original document from a duplicate document of said original document, comprising storage means for storing an original file containing said original document and a duplicate file containing said duplicate document, said original file having an original format, said duplicate file having a canonical format; embedding means for embedding notary data associated with said original file within said duplicate file; and validation means for authenticating said original file using at least said notary data associated with said original file (col. 2, lines 5-26 and col. 10, lines 10-38).



As per claim 54, it is taught by Pasieka wherein said validation means further comprises determining means for determining said original file from said duplicate file; extraction means for extracting said notary data associated with said original file from said duplicate file; notarization means for determining new notary data associated with said original file; and comparison means for comparing said new notary data with said extracted notary data to authenticate said original file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 78, Pasieka discloses of a method for validating the authenticity of digital documents of disparate types, comprising the steps of retrieving a duplicate file containing a duplicate document of an original document in an original file having an original format, said duplicate file having a canonical format, said duplicate file further having notary data associated with said duplicate file embedded within said duplicate file; and authenticating said duplicate file using at least said notary data associated with said duplicate file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 79, Pasieka teaches wherein said notary data is embedded into a hole within said duplicate file, said notary data being determined by computing a hash value over the contents of said duplicate file excluding said hole (col. 2, lines 5-26).

As per claim 80, it is disclosed by Pasieka wherein said step of authenticating further comprises the steps of extracting said notary data associated with said duplicate file from said hole; determining new notary data associated with said duplicate file by computing an additional hash value over the contents of said duplicate file excluding

said hole; and enabling comparison of said extracted notary data with said new notary data to authenticate said duplicate file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 81, it is taught by Pasioka of a method for validating the authenticity of an original document from a duplicate document of said original document, said method comprising the steps of retrieving a duplicate file containing a duplicate document of an original document in an original file having an original format, said duplicate file having a canonical format, said duplicate file further having notary data associated with said original file embedded within said duplicate file; and authenticating said original file using at least said notary data associated with said original file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 82, Pasioka discloses wherein said step of authenticating further comprises the steps of determining said original file from said duplicate file; extracting said notary data associated with said original file from said duplicate determining new notary data associated with said original file; and comparing said new notary data with said extracted notary data to authenticate said original file (col. 2, lines 5-26 and col. 10, lines 10-38).

As per claim 83, it is taught by Pasioka of a duplicate document of an original document, comprising at least one page; a footer at the bottom of each said at least one page; and a unique sequence number inserted in said footer, said unique sequence number including at least a portion of notary data associated with the original document to provide a cryptographically secure link between the duplicate document and the original document (col. 2, lines 5-26 and col. 10, lines 10-38).

***Allowable Subject Matter***

5. Claims 2-11,20-49, and 62-77 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: It was not found to be taught in the prior art of a duplicate digital document of an original digital document in an original file having an original format; embedded original notary data associated with said original file; embedded duplicate notary data associated with said duplicate file; and a unique sequence number including at least a portion of said original notary data to provide a cryptographically secure link between said duplicate file and said original file.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR  
  
August 7, 2006

CHRISTOPHER REVAK  
PRIMARY EXAMINER

 8/7/06